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Remarks/Arguments

Applicant wishes to thank the Examiner for discussing the above-listed patent application. A complete listing of all pending claims is submitted herewith. It is respectfully submitted that the claim amendments and accompanying remarks have been made to advance the claims to allowance, and as such, is completely responsive to the Final Office Action. No new matter has been added by the current amendments.

1. The Claims

Claims 7 recites, in part, the steps of "grasping the uncoupled portion of the silicone band" and "pulling the uncoupled portions of the silicone band while said first and second sheets are superimposed so as to uncover the adhesive tape strip and irreversibly bind the two sheets together." Claim 19 recites, in part, the steps of "grasping the uncoupled portion of the silicone bands extending from the successive sheets" and "pulling the uncoupled portions of the silicone bands extending from said sheets while said plurality of sheets are superimposed so as to remove the silicone bands and uncover the adhesive strips, thereby irreversibly binding successive sheets together."

As discussed in the Amendment of August 7, 2003, the claimed invention provides the significant advantage of allowing multiple sheets to be superimposed and then adhered together in a single operation (see, specification, page 2, lines 1-3 and 9-11).

2. The Claims are definite

Claim 7 was rejected under 35 U.S.C. §112, second paragraph. Claim 7 has been amended in response to the rejection, and it respectfully requested that the rejection be withdrawn.

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3. The Claims are not obvious

Claims 7 and 18-21 were finally rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 4,447,481 to Holmberg *et al.* (the "Holmberg" patent) in view of U.S. Patent No. 4,673,324 to Hanson *et al.* (the "Hanson" patent). In the Office Action, the Examiner states:

Regarding the strip being pulled from the sheets while the sheets are superimposed, the sheets of Holmberg are intended to be bound to an underlying surface by removing the protective strip to expose the adhesive portion. Inherently, the sheets are superimposed in order to form the bound-together booklet. (Office Action, page 3, ¶1.)

Given that Holmberg discloses that the "protective strip" is within the periphery of the sheet, the Examiner suggests a modification to Holmberg in order to be able to access the protective strip, since such disclosure is absent from Holmberg. In particular, the Examiner speculates that:

The protective strip *can* be removed from the sheet while the sheets are superimposed by bending the sheet located directly above the sheet to enable the protective strip to be removed. (Office Action, page 5, ¶1, emphasis supplied.)

Applicant respectfully disagrees and asserts that the claims are not obvious over Holmberg in view of Hanson. To render a claim obvious, the prior art must contain a suggestion to produce the claimed invention and evidence which would convey a reasonable expectation of success to the skilled artisan. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). The teaching or suggestion and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

First, Holmberg does not expressly disclose the sequence of steps recited in claim 7, e.g., pulling the uncoupled portion of the silicone band while the first and second sheets are superimposed. In particular, Holmberg, as excerpted below, describes that sheets are processed with a protective strip attached, and that the protective strip is removed before the sheets are attached:

It will be seen that this invention permits a sheet of paper having uniform thickness throughout its entire surface area to be provided which can be

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processed by conventional equipment after the adhesive and protective covering strip has been applied thereto, while still permitting the sheet to be quickly attached to another sheet either permanently or removably, depending upon the adhesive used, after removal of the protective strip. (Holmberg, col. 3, lines 1-9.)

However, Holmberg fails to describe, expressly or inherently, the step of superimposing the sheets *at the time* the protective strip is removed.

Second, the arrangement described in Holmberg actually teaches away from removing a protective strip while the sheets are superimposed. As discussed in Applicant's Amendment of August 7, 2003, the protective strip (ribbon 16) is located within the boundaries of each sheet 10 (see, column 2, line 67 – column 3, line 2; Figures 3-7). Since no means is disclosed by Holmberg for accessing the ribbon while another sheet has been superimposed over the first sheet, such configuration clearly suggests removal of the ribbon *before* the sheets are superimposed.

In the absence of a disclosure for accessing the protective strip while the sheets are superimposed, the Examiner states that “[t]he protective strip *can* be removed from the sheet while the sheets are superimposed by bending the sheet located directly above the sheet.” (emphasis supplied.) Modification of the cited art in this manner is not disclosed or suggested in the cited art, without relying on Applicant's disclosure. In particular, there is no suggestion in the cited art regarding the following teachings, e.g., superimposing the sheets at the time of attachment (as discussed above), or that after superimposing the sheets, a sheet overlying a sheet containing a protective strip may be bent to expose the protective strip for the purpose of attaching the sheets. Accordingly, the Examiner appears to be applying an impermissible hindsight modification to the reference. For these reasons, claim 7 is believed nonobvious and allowable over the art of record.

Claim 19 is believed allowable for the reasons discussed above concerning claim 7. In addition, claim 19 further recites the step of “grasping the uncoupled portion of the silicone bands extending beyond the successive sheets while a portion of each of said silicone bands is disposed between successive sheets” and “pulling the uncoupled

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portions of the silicone bands extending beyond said sheets while said plurality of sheets are superimposed so as to remove the silicone bands and uncover the adhesive strips."


Neither Holmberg nor Hanson disclose or suggest such steps. As discussed above, the ribbon 16 described in Holmberg lies within the periphery of the sheet, and therefore does not disclose or suggest "silicone bands extending beyond said sheets," as recited in the claim. Moreover, the Holmberg configuration provides no means for accessing the ribbon 16 while another sheet has been superimposed over the ribbon 16. Accordingly, it is believed that such features are not fairly disclosed or suggested by the art of record, and therefore claim 19 is believed nonobvious and allowable.

Claims 20 and 21, which depend from claim 19, are believed allowable at least for the reasons discussed above with respect to claim 19. It is respectfully requested that the rejection under 35 U.S.C. §103 be withdrawn with respect to claims 7 and 19-21.

Applicant respectfully requests reconsideration of the application and entry of the amendments. Applicant submits that the application is in condition for allowance, and that a Notice of Allowance be issued in this case. The Examiner is invited to contact the undersigned at (212) 408-2561 to expedite the prosecution of this application if any issues remain outstanding.

Respectfully submitted,

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